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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,683	07/16/2001	Jamie M. Grooms	197319US/222962US	4376

7590 03/16/2004

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EXAMINER
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SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 03/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/905,683	GROOMS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Bruce E Snow	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 111-128 is/are pending in the application.
- 4a) Of the above claim(s) 119 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 118 and 120-128 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11212002, 12032001</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Species 3 (figures 7) in Paper No. 0202004 is acknowledged. The traversal is on the ground(s) that the species shown in figure 9 should be included with Species 3. This is not found persuasive. It is noted that the two figures show patentable distinct features not inclusive to both, such as elements 701-704 of figures 7 and element 904 in figure 9. All claims 111-118 and 120-128 read on the elected Species; claim 119 is withdrawn.

The requirement is still deemed proper and is therefore made FINAL.

### ***Double Patenting***

All claims are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of all claims of copending Application No. 10/375,540. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 111-118 and 120-128 are rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (5,989,289) in view of Siebels (EP 517030).

Referring to all figures, Coates teaches a D-shaped cortical bone spinal implant (see

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column 11, lines 42 et seq.). However, Coates et al fails to teach said implant can comprise a first and second portion capable of being connected by a pin. Siebels also teaches a spinal implant and teaches stacking portions 11 of the implant and connecting said portions with pins 17. It would have been obvious to one having ordinary skill in the art to have utilized the teachings of Siebels to stack and connect individual implant portions with the D-shaped cortical bone implant of Coates wherein multiple portions could be stacked and connected by at least one pin in corresponding through holes to adjustably build the implant to a desired height (thickness) to best fill the disc space as desired by the surgeon.

Regarding at least claims 114, 123, and 127, lacking any criticality in the specification, the use of the claimed materials such as titanium in lieu of those taught by Seibels produce no advantage and is considered an obvious matter of design choice.

Additionally, Coates teaches the use of metal devices are foreign bodies which can never be fully incorporated in the fusion mass and produce stress shielding because the stiffness values do not match that of bone (column 2, lines 34 et seq.). Therefore, it would have been obvious to one having ordinary skill in the art to have constructed the pin out of cortical bone or cancellous bone which can be fully incorporated and does not produce stress shielding.

Regarding claim 122, see column 11, lines 62 et seq.

Regarding claims 124 and 128, Coates et al teaches treating the spacer with BMP which would include the pins.

All other claimed limitations are self-evident.

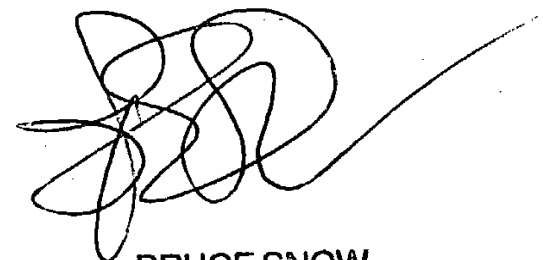
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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BRUCE SNOW  
PRIMARY EXAMINER